

REMARKS

The Examiner has made a restriction requirement under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Specifically, the Examiner required election between either a (1) fibrous or a (2) liquid binder material. Upon allowance of the generic claim, Applicant is entitled to consideration of claims to the additional nonelected species.

As stated in paragraph seven of the Office Action mailed on September 12, 2005, the undersigned provisionally elected with traverse to prosecute the invention of claims 10-17, and 23-28 wherein a fibrous binder material is required. Applicant again affirms this election here.

This Amendment and Response to Final Office Action is being submitted in response to the Final Office Action mailed June 29, 2006. Claims 1-7, 9-17 and 29-34 are pending in the Application. Claims 29-32 are withdrawn from consideration. Claims 1-7, 9-17, 33 and 34 stand rejected 35 U.S.C. § 112, first paragraph, as nonenabling and under 35 U.S.C. § 112, second paragraph, as being indefinite.

In addition, claim 2 remains rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for containing a broad limitation followed by a narrow limitation. As noted in section 8 of the Final Office Action, the above amendment which was inadvertently omitted from the response of March 18, 2006, will overcome this rejection of claim 2.

Claims 1-7, 9-17, 33 and 34 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-24 of copending Application No. 10/392999.

Based upon the amendment, reconsideration of the Application is respectfully requested in light of the following remarks.

Rejection of Claim 2 under 35 U.S.C. § 112, second paragraph, as being indefinite for containing a broad limitation followed by a narrow limitation

As noted above, the Examiner has stated that the concurrently filed amendment to claim 2 overcomes this rejection. Withdrawal of this rejection is courteously solicited.

Rejection of Claims 1-7, 9-17, 33 and 34 under 35 U.S.C. § 112, First Paragraph (enablement) and Second Paragraph

Claim 1, the sole independent claim that is subject to these rejections requires, *inter alia*, “from about 25 to 75 wt. % synthetic and/or natural fiber coated with FR resin material, and uncoated synthetic and/or natural fiber.” Both the enablement and definiteness rejection revolve around the scope or meaning of the word “uncoated” as used in this portion of claim 1. This is seen from the Examiner’s statements in section 7 of the Final Office Action that the enablement rejection is maintained because “the scope of ‘uncoated’ is not clearly set forth” and that the definiteness rejection is maintained because “it is not clear what exactly is intended by ‘uncoated.’”

Under these circumstances it is necessary to consider the definiteness rejection first since one is not in a position to determine whether a claim is enabled under 35 U.S.C. § 112, first paragraph, until the metes and bounds of the claim are determined under the second paragraph of this section of the statute. *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971), (“It may appear awkward at first to consider the two paragraphs in inverse order but it should be realized that when the first paragraph speaks of ‘the invention,’ it can only be referring to that invention which the applicant wishes to have protected by the patent grant, i.e., the claimed invention. For this reason the claims must be analyzed first in order to determine exactly what subject matter they encompass.”)

Turning to the definiteness issue, it is noted that “as an initial matter, the PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant’s specification.” In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). Here the specification provides enlightenment as to the meaning of “uncoated” as this word is used in Claim 1. Specifically, the phrase “uncoated synthetic and/or natural fiber” means that these fibers are not coated with a FR coating as seen from page 11, first full paragraph of the specification where it is stated “[v]arious nonwoven batts made from synthetic or natural fibers with and without an FR coating...”. Thus, “uncoated synthetic and/or natural fibers” used in the nonwoven article of this invention may be coated with materials that are typically used in the manufacture of the fibers or other functional coatings, provided that the coating is not a FR coating. Therefore a person of ordinary skill in the art would understand from the enlightenment provided by the specification that the uncoated synthetic and/or natural fibers required by claim 1 must not be coated with a FR material.

From the above analysis, it is believed that the scope of claim 1 is readily discerned when the enlightenment offered by the specification is taken into account as required by *Morris*. However, if the examiner believes that claim 1 would be clearer if amended to recite “and ~~uncoated~~ synthetic and/or natural fiber not coated with FR material,” the examiner is hereby authorized to enter an Examiner’s Amendment to this effect. Alternatively, if the Examiner believes that other language is needed, it is respectfully requested that the Examiner telephone the undersigned so that such language can be discussed.

Withdrawal of this portion of the rejection is courteously solicited.

Having clarified the scope of the word “uncoated” as used in Claim 1, it is believed that the Examiner’s concerns regarding the enablement of this claim are satisfied. In this regard it is noted that in order for the Examiner to establish a *prima facie* case of non-enablement the examiner has to provide a fact-based analysis of the factors set forth in *In re Wands*, 858 F.2d 731, 736-37, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).¹ Instead of such an analysis, the Examiner has only stated that “the scope of ‘uncoated’ is not clearly set forth.” Final Office Action, section 7.

Withdrawal of this portion of the rejection is courteously solicited.

Rejection of Claims 1-7, 9-17, 33 and 34 under the judicially created doctrine of obviousness-type double patenting over claims 1-24 of co-pending Application No. 10/392999

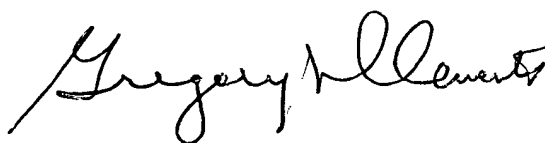
Applicant will file a terminal disclaimer upon allowance of the pending claims.

CONCLUSION

Applicant would like to thank the Examiner for the attention and consideration accorded the present Application. Should the Examiner determine that any further action is necessary to place the Application in better form for allowance, The Examiner is encouraged to contact undersigned Counsel at the telephone number, facsimile number, address, or email address provided below. It is not believed that any fees for additional claims, extensions of time, or the like are required beyond those that may otherwise be indicated in the documents accompanying this paper. However, if such additional fees are required, Examiner is encouraged to notify undersigned Counsel at the Examiner’s earliest convenience.

¹ Those factors are (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404.

Respectfully submitted,



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